



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/674,702

09/30/2003

Gail K. Buehler

MCP5017

4561

27777 7590 04/15/2009
PHILIP S. JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

EXAMINER

SOROUGH, LAYLA

ART UNIT

PAPER NUMBER

1617

MAIL DATE

DELIVERY MODE

04/15/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/674,702	Applicant(s) BUEHLER ET AL.	
	Examiner LAYLA SOROUGH	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17, 19, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/23/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 2, 2009. Claims 1-19, 21-22 are pending.

The following rejections are made:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17, 19, 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gowan, Jr. (US 5374659 A—previously presented), Gergely et al. (US 5834019 A – previously presented), Patel et al. (US Pat No. 6569463), Eichman (US Pat. No. 5,980,882—previously presented), and Hagemann et al. (US Pat 5,211,957)

Gowan, Jr. teaches an aqueous pharmaceutical suspension composition comprising an insoluble pharmaceutical active, a suspension stabilizing effective

Art Unit: 1617

amount of xanthan gum (hydrocolloid and thickener), pregelatinized starch (swelling agent and thickener) and polyoxyethylene sorbitan monooleate (surfactant) (see abstract). The pH of the composition is preferably between 3.5 and 5 (col 5 line 6).

Application of the compositions and method of the present invention for medical and pharmaceutical uses can be accomplished by any clinical, medical and pharmaceutical methods and techniques as are presently or prospectively known to those skilled in the art. Thus it is intended that the present invention cover the modifications and variations of this invention provided that they come within the scope of the appended claims and their equivalents (col 7 lines 54-61).

The reference fails to teach the active agent, Loratadine, the nucleation inhibitor, PVP, and the amino polycarboxylic acid compound, EDTA.

Gergely et al. is solely used to show that Loratadine is virtually completely water-insoluble and has a very strongly hydrophobic character. It is thus extremely poorly wettable and therefore difficult to suspend. Its fine particles furthermore have the tendency to form a film on the water surface, to creep up the glass wall to a pronounced extent and to adhere relatively strongly there.

Patel et al. teaches "compositions of the present invention can be used for improved delivery of hydrophilic or hydrophobic pharmaceutical active ingredients, such as drugs, nutritional, cosmeceuticals and diagnostic agents (Col 28 line 57-67)." Such pharmaceuticals include loratadine. The pharmaceutical compositions can include one or more additive such as solubilizers, i.e., additives to increase the solubility of the pharmaceutical active ingredient (col 29 lines 16-21). The "solid pharmaceutical

Art Unit: 1617

compositions of the present invention can optionally include one or more additives, sometimes referred to as excipients. The additives can be contained in an encapsulation coat in compositions which include an encapsulation coat, or can be part of the solid carrier, such as coated to an encapsulation coat, or contained within the components forming the solid carrier. Alternatively, the additives can be contained in the pharmaceutical composition but not part of the solid carrier itself (col 28 lines 57-67)."

Hence reading on the limitation uniformly dispersed nucleation inhibitor of claim 1.

Preferred solubilizers for use in the compositions include triacetin, triethylcitrate, ethyl oleate, ethyl caprylate, dimethylacetamide, N-methylpyrrolidone, N-hydroxyethylpyrrolidone, polyvinylpyrrolidone(nucleation inhibitor) (Col 29 line 57-60).

Other additives include enzyme inhibitors and chelating agents such as EDTA.

Additionally, Patel et al. teaches "Spherical particles are preferred, and these may be produced through spheronization or a spherical crystallization process. Crystals or compact granules from dry compaction or extrusion processes, often available commercially, serve as good substrates (col 41 lines 5-10)."

Eichman teaches drug resin complexes stabilized by chelating agents. "The particle size of a resin can differ between two resins." The chelating agent is preferably EDTA (amino polycarboxylic acid compound). EDTA is known to stabilize drugs in solution by retarding their oxidation col 2 lines 60-61).

Hagemann et al. teaches pharmaceutically acceptable excipients including PVP are, in particular viscosity index improvers which are suitable for stabilising aqueous suspensions and which inhibit sedimentation (col 4 lines 42-65).

Art Unit: 1617

It would have been obvious to one of ordinary skill in the art to combine the teachings of Gowan, Jr., Gergely et al., Patel et al., Eichman, and Hagemann et al. The motivation to combine the teachings is because (1) Gowan, Jr. teaches an aqueous pharmaceutical suspension composition comprising an insoluble pharmaceutical active, a suspension stabilizing effective amount of xanthan gum (hydrocolloid and thickener), pregelatinized starch (swelling agent and thickener) and polyoxyethylene sorbitan monooleate (surfactant) (see abstract). Application of the compositions and method of the present invention for medical and pharmaceutical uses can be accomplished by any clinical, medical and pharmaceutical methods and techniques as are presently or prospectively known to those skilled in the art. Thus it is intended that the present invention cover the modifications and variations of this invention provided that they come within the scope of the appended claims and their equivalents (col 7 lines 54-61); (2) Gergely et al. teaches Loratadine is virtually completely water-insoluble and has a very strongly hydrophobic character. It is thus extremely poorly wettable and therefore difficult to suspend. Its fine particles furthermore have the tendency to form a film on the water surface, to creep up the glass wall to a pronounced extent and to adhere relatively strongly there., (3) Patel et al., teaches solubilizers for use in the compositions include triacetin, triethylcitrate, ethyl oleate, ethyl caprylate, dimethylacetamide, N-methylpyrrolidone, N-hydroxyethylpyrrolidone, polyvinylpyrrolidone(nucleation inhibitor) (Col 29 line 57-60). Other additives include enzyme inhibitors and chelating agents such as EDTA (4) Eichman teaches drug resin complexes stabilized by chelating agents. "The particle size of a resin can differ between two resins." The chelating

Art Unit: 1617

agent is preferably EDTA (amino polycarboxylic acid compound). EDTA is known to stabilize drugs in solution by retarding their oxidation (col 2 lines 60-61) and (5) Hagemann et al. teaches pharmaceutically acceptable excipients are, in particular viscosity index improvers which are suitable for stabilizing aqueous suspensions and which inhibit sedimentation include PVP (col 4 lines 42-65). A skilled artisan would have reasonable expectation of effectively stabilizing loratadine (antihistamine) a water-insoluble pharmaceutical active.

Gowan, Jr., Gergely et al., Patel et al., and Eichman meet all elemental steps of the instant claims and the compositions created thereof. Since the compositions prepared by Gowan, Jr., Gergely et al., Patel et al., and Eichman meet all elemental components of the instantly prepared composition, they would obviously exhibit the same properties as recited in claims 8-10 and 22. Although the reference teaches within the embodiment of the invention crystalline drug forms are envisaged, whether the drug is in crystal form or amorphous form does not effect the composition. Hence, the various forms are rendered obvious by the teachings of the prior art.

Response to Arguments

Applicant's arguments filed April November 25, 2008 have been fully considered.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

Art Unit: 1617

the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, The motivation to combine the teachings is because (1) Gowan, Jr. teaches an aqueous pharmaceutical suspension composition comprising an insoluble pharmaceutical active, a suspension stabilizing effective amount of xanthan gum (hydrocolloid and thickener), pregelatinized starch (swelling agent and thickener) and polyoxyethylene sorbitan monooleate (surfactant) (see abstract). Application of the compositions and method of the present invention for medical and pharmaceutical uses can be accomplished by any clinical, medical and pharmaceutical methods and techniques as are presently or prospectively known to those skilled in the art. Thus it is intended that the present invention cover the modifications and variations of this invention provided that they come within the scope of the appended claims and their equivalents (col 7 lines 54-61); (2) Gergely et al. teaches Loratadine is virtually completely water-insoluble and has a very strongly hydrophobic character. It is thus extremely poorly wettable and therefore difficult to suspend. Its fine particles furthermore have the tendency to form a film on the water surface, to creep up the glass wall to a pronounced extent and to adhere relatively strongly there., (3) Patel et al., teaches solubilizers for use in the compositions include triacetin, triethylcitrate, ethyl oleate, ethyl caprylate, dimethylacetamide, N-methylpyrrolidone, N-hydroxyethylpyrrolidone, polyvinylpyrrolidone(nucleation inhibitor) (Col 29 line 57-60). Other additives include enzyme inhibitors and chelating agents such as EDTA (4) Eichman teaches drug resin complexes stabilized by chelating agents. "The particle size of a resin can differ between two resins." The chelating

Art Unit: 1617

agent is preferably EDTA (amino polycarboxylic acid compound). EDTA is known to stabilize drugs in solution by retarding their oxidation (col 2 lines 60-61) and (5) Hagemann et al. teaches pharmaceutically acceptable excipients are, in particular viscosity index improvers which are suitable for stabilizing aqueous suspensions and which inhibit sedimentation include PVP (col 4 lines 42-65). A skilled artisan would have reasonable expectation of effectively stabilizing loratadine (antihistamine) a water-insoluble pharmaceutical active.

Conclusion

No claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Layla Soroush whose telephone number is (571)272-5008. The examiner can normally be reached on Monday through Friday from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Art Unit: 1617

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/SREENI PADMANABHAN/

Supervisory Patent Examiner, Art Unit 1617